

### **REMARKS/ARGUMENTS**

Claims 1, 3-5, and 7-12 remain in this application. Claim 1 has been amended. New claims 22 to 31 have been added to better claim the invention. There are now 20 claims in the case and 2 independent claims. Accordingly, no excess claim fees are due.

The Examiner has issued a final Office Action on August 18, 2008. Accordingly, this response is being filed together with a request for continued examination. The Applicants respectfully submit that the claims fully distinguish over the prior art cited to date by the Examiner and further examination is respectfully requested.

#### **35 U.S.C. § 101 Rejections**

The Examiner has rejected all of the claims in this application under 35 U.S.C. § 101 as non-statutory subject matter. The Examiner takes the position that the process steps in claims 1, 3-5, and 7-12 are not tied to another statutory class nor do they execute a transformation.

In *In re Bilski*, \_\_\_ F.3d \_\_\_ (Fed. Cir. 2008), the Court of Appeals for the Federal Circuit, citing the Supreme Court in *Gottschalk v. Benson*, 409 U.S. 63, recently restated a “definitive” test for patent eligibility of process subject matter under § 101 as:

A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.

Furthermore, the Court held that “the machine-or-transformation test is the only applicable test and must be applied in light of the guidance provided by the Supreme Court and this court, when evaluating the patent-eligibility of process claims” [emphasis

added]: *In re Bilski* at 29. The Court went on to cite two additional corollaries to the machine-or-transformation test:

... the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility: *Benson*, 409 U.S. at 71-72.

... the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity: *Parker v. Flook*, 437 U.S. at 590.

Interpreting related case law, the Court elaborated, "mere field-of-use limitations are generally insufficient to render an otherwise ineligible process claim patent-eligible": *In re Bilski* at 15. The Court opined that "pre-emption of all uses of a fundamental principle in all fields and pre-emption of all uses of the principle in only one field" indicates that a claim is not limited to a particular application: *Ibid.* at 16. However, "a claim that is tied to a particular article does not pre-empt all uses of a fundamental principle in any field but rather is limited to a particular use, a specific application": *Ibid.* It follows that a claim that recites use of a "particular article" in performing core elements of the claim imposes a meaningful limit on the claim's scope, sufficient to impart patent-eligibility.

Accordingly, independent claim 1 is currently amended to recite "communicating from a mobile device" and "receiving at the mobile device". Support for the amendments may be found, for example, at paragraph 13 of the specification. It is respectfully submitted that the amendments to the claim tie the process to a particular machine or apparatus (i.e., a mobile device).

Furthermore, use of the mobile device in carrying out steps of the method does not occur before or after the main body of the claimed process; rather, the mobile device is used in integral elements of the claimed process. In other words, the

limitations of "communicating from a mobile device" and "receiving at the mobile device" cannot be considered mere "insignificant post solution activity".

New independent claim 22 recites the use of a particular apparatus (e.g., routing means). Applicant submits that claim 22 is allowable for analogous reasons. In particular, support for "routing means" may be found at paragraphs 15 and 16 of the specification. Support for "communication means" may be found at paragraph 52. Applicant notes that claim 22 recites claim limitations in means-plus-function terms. Per the Court of Appeals for the Federal Circuit in *In re Donaldson Co.*, 16 F.3d 1189 (Fed. Cir. 1994), such limitations are necessarily limited to what is disclosed in the specification (see also MPEP § 2181). As such, means-plus-function limitations inherently recite a particular machine or apparatus disclosed in the specification and therefore impose meaningful limits on the scope of the claim.

Accordingly, it is respectfully submitted that independent claims 1 and 22 are tied to a particular machine or apparatus and therefore constitute statutory subject matter. Likewise, dependent claims 3-5, 7-12 and 23-31 are similarly allowable at least because they depend on their respective base claims and also due to the further limitations they recite.

### **35 U.S.C. § 103 Rejections**

The Examiner has also rejected claims 1, 3-5 and 7-12 under 35 U.S.C. § 103(a) as being unpatentable over Huxter (U.S. Patent Publication No. 2002/0103724), in view of Kuebert et al. (U.S. Patent Publication No. 2002/0165729).

The Examiner takes the position that Huxter discloses attempting a delivery at a primary location, if the delivery to the primary location fails, communicating a notification to the recipient of an upcoming delivery to a preferred redirection location. Further, the Examiner takes the position that Kuebert discloses:

- 1) selecting the preferred redirection location prior to the delivery and also discloses alternate delivery locations, therefore more than one; and
- 2) discloses receiving a response to the notification from the recipient after a failed delivery, wherein the response to the notification is adapted to change the preferred redirection location to an alternative redirection location, and delivering the parcel to the alternative redirection location.

Accordingly, the Examiner takes the position that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Huxter's invention with Kuebert's use of selecting an alternate location prior to delivery, and multiple delivery locations in order that "the recipient, sender, or mailer may flexibly change the delivery point of the item". The Examiner's position is respectfully traversed.

The Examiner again appears not to have considered Applicant's previous arguments regarding the teachings of Huxter. In the second paragraph at page 3 of the Office Action, the Examiner argues that Huxter discloses "attempting a delivery at a primary location; if the delivery to the primary location fails, communicating a notification to the recipient of an upcoming delivery to a preferred redirection location." Without providing substantive arguments, the Examiner merely repeats the earlier rejection citing Huxter, which was rebutted by Applicant in the previous reply to the office action of March 10, 2008 and the interview of December 5, 2007. In the interview, the Examiner agreed with the undersigned that Huxter does not teach permitting the recipient to change the location to an alternative redirection location in the recipient's response to the failed delivery notification. However, despite having earlier agreed with Applicant, the Examiner has once again and without explanation taken the opposite position.

Applicant refers the Examiner to MPEP § 707.07(f):

In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

[...]

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

Accordingly, if the Examiner elects to maintain the rejection on these grounds, Applicant respectfully requests that the Examiner answer the substance of Applicant's traversal and provide reasons why Applicant's arguments are not persuasive. If there is some misunderstanding regarding the Examiner's position, the Examiner is invited to telephone the undersigned at the number below to discuss this matter. In any event, for completeness, the Applicant again addresses each of the cited passages and figures from Huxter.

With respect to box 109 in Figure 8, this box says nothing other than the customer can build a list of preferred alternate collection points to be used for deliveries. Box 109 contains no disclosure of notifying the recipient of a failed delivery or the ability by the recipient to reply by providing an alternate redirection location. During the interview, the undersigned referred the Examiner to paragraphs 174 and 175, which describe the process illustrated in Figure 8. The first sentence of paragraph 174 clearly describes a process by which the customer registers with the parcel delivery system. It is clear that customer registration (and therefore the selection of any redirection locations) must occur prior to any delivery attempt. Accordingly, Figure 8 does not disclose any method or process which relates to notification following a failed delivery attempt, or any responses to such notification which permits the recipient to change the delivery location to an alternative redirection location selected after a failed delivery. Box 109 does not disclose attempting a delivery at a primary location. On the other hand, paragraph 211 does teach making a delivery or collection, but this is only in the context of the closed doors 1300 step of the Delivery 300 or Collect Goods 400 processes (i.e., paragraph 211 does not teach communicating a notification to the recipient if the delivery to the primary location fails).

With respect to box 340 in Figure 10A, the box states "application server sends messages to delivery company confirming successful delivery". Consequently, box 340 clearly refers to notification of a successful delivery (i.e. recipient receives parcel). There would be no point for the recipient to select an alternative redirection location after he or she received the parcel. Claim 1 clearly recites communicating the notification to the recipient only if the delivery to the primary location fails. It should be noted that box 340 is not described anywhere in the written description of Huxter. Paragraph 17 of Huxter states that "...upon receipt of the package by the automated collection point, the customer will automatically be sent a message containing notification of delivery". Again, this passage clearly refers to a notification of a successful delivery. This is clearly different from the notification of an upcoming delivery in the event of a failed delivery attempt, as recited in claim 1. Again, there would be no point to changing the delivery location to an alternative redirection location after the recipient has already received the parcel.

With respect to paragraph 189, this paragraph teaches sending of failed delivery message to an application server. However, there is no disclosure of a notification of an upcoming delivery to another location (recited in claim 1). In addition, claim 1 recites that the notification is directed to the recipient rather than the application server.

Finally, paragraph 203 of Huxter merely teaches sending an order expiry message to the customer. Again, there is no disclosure of an upcoming delivery to any kind of redirection location.

Additionally, the Examiner takes the position that Kuebert "discloses selecting the preferred redirection location prior to the delivery and also discloses alternate delivery locations, therefore more than one" and that Kuebert discloses "receiving a response to the notification from the recipient after a failed delivery, wherein the response to the notification is adapted to change the preferred redirection location to an alternative redirection location, and delivering the parcel the alternate redirection location". The

Examiner cites the abstract and paragraphs 17, 28-29, 41 and 47-48 in support of this position. The Examiner's position is respectfully traversed.

Applicant concedes that Kuebert discloses more than one delivery address. However, Kuebert fails to teach "receiving a response to the notification from the recipient after a failed delivery, wherein the response to the notification is adapted to change the preferred redirection location".

The abstract and paragraph 17 of Kuebert merely teach that the recipient, sender, or mailer may act alone or in combination with each other when changing the delivery point of the mail item. That is, they do not indicate how or when the delivery point may be changed.

Paragraphs 28 and 29 of Kuebert teach building "a secure, static database of information associated with each delivery point to which it delivers to [sic]" [emphasis added]. The static database may also contain other information such as "preapproved alternate delivery points, [...], anything of a 'permanent' nature about the recipient, as contrasted to the 'temporary' information about mail item 100" [emphasis added] which is used to notify parties of fraudulent redirection attempts. Clearly, a notification of fraudulent redirection must be sent before attempted delivery. More importantly, a response to such notification must be sent and received prior to the attempted delivery, because not all delivery attempts will be unsuccessful, leading to a high likelihood of fraudulent redirections. In other words, a person of ordinary skill in the art at the time of the invention reading paragraphs 28 and 29 of Kuebert would be taught away from providing responses to the notifications after attempted delivery (as recited in claim 1).

Paragraph 41 of Kuebert teaches that the recipient may be notified as the mail item progresses along the delivery route. Although paragraph 41 teaches that a notification of a failed delivery attempt may be made, it does not teach that the recipient may change the preferred redirection location after such notification. Furthermore, it

does not teach that the response to the notification is adapted to change the preferred redirection location.

Paragraphs 47 and 48 of Kuebert refer to process steps 230 and 235 in Figure 2 and disclose that the recipient may specify a new delivery point, but do not indicate that the preferred delivery point may be changed after a delivery attempt. In other words, Kuebert again does not teach “receiving a response to the notification from the recipient after a failed delivery, wherein the response to notification is adapted to change the preferred redirection location”.

For completeness, Applicant further notes that at paragraphs 49 and 54, which the Examiner has not cited, Kuebert apparently teaches delivering a mail item to an alternate address in the event that it is undeliverable. However, in both cases only the sender of the message or of the mail may specify a new delivery point for the mail. This is consistent with the approach taught by Kuebert of preventing fraudulent redirection of mail (see, for example, paragraph 29). In other words, Kuebert does not disclose “receiving a response to a notification from the recipient after a failed delivery, wherein the response to the notification is adapted to change the redirection location to a alternate redirection location”. Accordingly, it is respectfully submitted that neither Huxter nor Kuebert alone or in combination disclose all the elements of claim 1.

Furthermore, Applicant submits that both Huxter and Kuebert fail to disclose “communicating from a mobile device” and “receiving at the mobile device” as recited in currently amended claim 1.

Because new claim 22 recites substantially similar limitations as claim 1, it is patentable over the combination of Huxter and Kuebert for the reasons discussed above.



## Conclusion

In light of the above, the Applicant respectfully submits that Huxter and Kuebert, alone or in combination, do not teach every limitation recited in claim 1 or claim 22. Because the remaining claims depend from allowable base claims, the Applicant respectfully submits that the remaining claims are also allowable.

Applicant requests that timely notice of allowance be issued in the case.

Respectfully submitted,

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